

Application No. 10/636,178

**REMARKS**

Claims 29-66 are pending. By this Amendment, claims 1-28 are canceled and new claims 29-66 are added.

35 U.S.C. §§ 102 and 103

Applicants acknowledge the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e, f, or g) prior art under 35 U.S.C. § 103(a).

The Office Action rejected claims 1-28 under 35 U.S.C. § 103(a) as obvious over U.S. 5,704,834 ("Sells"), in view of U.S. 6,308,472 ("Coulton"). The Office action also rejected claims 1-28 over Coulton in view of U.S. Sells. Applicants respectfully traverse these rejections. However, in order to advance the prosecution of this Application, claims 1-28 are canceled and the rejections are deemed moot. Applicants submit that all pending claims are allowable over the cited U.S. patents.

Notwithstanding that all rejections are deemed moot, Applicant respectfully traverses that a prima facie case of obviousness has been established with respect to the pending claims. In order to establish a prima facie case of obviousness, a rejection must cite documents which teach or suggest all the claim limitations<sup>1</sup> and establish a proper motivation for modifying the documents cited against the claims.<sup>2</sup> The motivation to modify the documents cited against the claims must be present in the documents themselves or generally in the prior art at the time of the instant invention, not in the instant application.<sup>3</sup> That the disclosures of the documents cited against the claims can be modified or that the asserted modification is within the ability of a

<sup>1</sup> See M.P.E.P. 2143 ("To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.").

<sup>2</sup> See M.P.E.P. § 2142 ("To establish a prima facie case of obviousness. ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination ... must ... be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).").

<sup>3</sup> See M.P.E.P. § 2142 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.").

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person of ordinary skill in the art is not sufficient to establish the required motivation.<sup>4,5</sup> Moreover, neither conclusory statements within the rejection nor subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.<sup>6,7</sup> Indeed, if the rejection asserts that the motivation was generally present in the art at the time of the invention, the Examiner may be required to execute an affidavit or declaration to that effect so that the Applicant may have the opportunity to explain or dispute the assertions

<sup>4</sup> See M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.").

<sup>5</sup> See M.P.E.P. 2143.01 ("A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. In re Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also, In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references..)" (emphasis added).

<sup>6</sup> See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002) ("This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.")(emphasis added).

<sup>7</sup> See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002) ("The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion."") (internal quotation marks omitted) (emphasis added).

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therein.<sup>8</sup> Additionally, evidence of patentability is established if the disclosures of the cited documents actually teach away from the asserted modification.<sup>9</sup>

In paragraph 3 of the Office Action rejected claims 1-28 as obvious over Sells in view of Coulton. In the rejection the Office action states,

Sells shows a roof vent comprising a vent housing with a plurality of stacked panels defining a plurality of flow passages 132 and a thin sheet of air permeable, water resistant material 38 disposed to restrict the wind driven precipitation to the interior of the structure to be ventilated. However, Sells does not show the thin sheet of air permeable, water resistant material located interior to the plurality of flow passages. Patent to Coulton et al teaches a roof ridge vent with air permeable, water resistant filter 44 located interior to the plurality of flow passages same as claimed.

The rejection then improperly concludes "Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate air permeable, water resistant filter 38 to the interior to the plurality of flow passage as taught by Coulton et al in order to improve the ventilation efficiency." As shown above, the motivation to modify the disclosure of Sells with the disclosure of Coulton must be present either in Sells, Coulton or generally in the art at the time of the invention. Applicant can find no such motivation in Sells or Coulton and respectfully asserts that the required motivation was not generally present in the art at the time of this invention. If the rejection is maintained, the Examiner is respectfully required to execute an affidavit or declaration showing with specificity that the required motivation was generally present in the art at the time of this invention, Applicant reserving the right to explain or contradict the affidavit or declaration. Alternately, the Examiner is respectfully required to

<sup>8</sup> See M.P.E.P. § 2144.03 ("As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 59 USPQ2d 1693, 1697.... If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) ("When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons'").") (emphasis added).

<sup>9</sup> See MPEP § 2155.05 III ("A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)").

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cite portions of Sells and/or Coulton with the asserted motivation. As shown above, Applicant further and respectfully points out that the subjective and unsubstantiated opinion expressed in the conclusory rejection is also not sufficient to establish the required motivation. Additionally, that the proposed modification can be accomplished or would have been within the ability of the person of ordinary skill in the art is not sufficient to establish the required motivation. Because the required motivation to modify the disclosure of Coulton with the disclosure of Sells has not been established, a prima facie case of obviousness has not been established as well and reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-28 are rejected as obvious over Coulton in view of Sells. Applicant respectfully traverses this rejection because a motivation to modify the disclosure of Coulton with the disclosure of Sells has not been established. The rejection states

Patent to Coulton et al. shows a roof vent comprising a vent housing with a plurality of flow passages (not numbered) and an air permeable, water resistant filter 44 disposed interior to the plurality of flow passages to restrict the wind driven precipitation to the interior of the structure to be ventilated. However, patent to Coulton et al. does not show a thin sheet of air permeable, water resistant filter and ventilating portions formed from three-ply material of corrugated plastic sheeting. Sells teaches a roof ridge vent with a thin sheet of air permeable, water resistant filter 38 and ventilating portions formed from a three-ply material of corrugated plastic sheeting same as claimed.

Again, the rejection - without stating supporting portions of Coulton or Sells - concludes, "Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the thin sheet of air permeable, water resistant filter 38 and ventilating portions 24, 26 of Sells for the filter 44 and ventilation portion 30 of Coulton et al. in order to improve the ventilation efficiency." This rejection is improper because the motivation is one of subjective opinion - unsupported by citations from Coulton or Sells or by an affidavit or declaration (as discussed above). If this rejection is maintained, the Examiner is respectfully required to either cite portions of Coulton or Sells supporting the asserted motivation or to execute an affidavit or declaration (as discussed above). Additionally, that the proposed modification can be accomplished or would have been within the ability of the person of

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ordinary skill in the art is not sufficient to establish the required motivation. Because a proper motivation to modify Coulton with Sells has not been shown, a prima facie case of obviousness has not been established and reconsideration and withdrawal of the rejection are respectfully requested.

Double Patenting

Claims 1-28 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-13 of U.S. Patent 6,450,882 and over claims 1-23 of U.S. Patent 6,632,354. Claims 28 are cancelled. Moreover, the pending claims are asserted not to be rejectable under the judicially created doctrine of obviousness-type double patenting. However, a terminal disclaimer will be considered if the pending claims are subsequently deemed to be rejectable under this doctrine.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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